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BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	85864264
Applicant	Shanon Preston
Applied for Mark	GET CENSORED
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In The United States Patent And Trademark Office
Before the Trademark Trial and Appeal Board

Mark: **GET CENSORED [plus design]**

Applicant: **Shanon Preston**

Serial No.: **85/864,264**

Filing Date: **Mar. 1, 2013**

Examining Attorney: **Wendell S. Phillips III**

Law Office No.: **110**

Attorney Docket No.: **13#626**

Applicant's Brief

Applicant hereby appeals the Examining Attorney's final refusal to register Applicant's mark, GET CENSORED [*plus design*] for apparel.

The Examining Attorney's final refusal was based on the Examining Attorney's belief that Applicant's Mark is likely to be confused with the mark CENSORED shown in US Registration No. 4,144,833 for apparel. Applicant believes and has shown the following facts in support of registration to overcome, respectfully, the Examiners refusal:

1. the goods, while normally related, travel in different trade channels and Applicant has amended its *goods and services description* to indicate its precise channel of trade, that is, *only the owner's online store*; and
2. in light of the distinct channels of trade, the commercial impressions differ enough to avoid a likelihood of confusion because consumers would encounter each mark pursuant to a distinct consuming experience.

Brief Recitation of the Facts and Evidence

Applicant originally applied for the mark GET CENSORED based on intent to use. Applicant has been using this mark in commerce since at least April 2013, but, is delaying filing a Statement of Use pending the outcome of this appeal.

The Examiner originally refused registration based on an additional mark, that is, SINSORED (having reg. no. 3,279,611) for shirts. The Examiner withdrew this basis for refusal after considering Applicant's argument in response to the original office action.

Which DuPont Factors are relevant to a determination of a likelihood of confusion?

It is well established that the following DuPont factors are relevant in any likelihood of confusion analysis during examination of a trademark application. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973).

- The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.
- The relatedness of the goods or services as described in the application and registration.

In addition, the following factors is also relevant to the analysis in this case:

- The similarity or dissimilarity of established, likely-to-continue trade channels.
- See, e.g., du Pont*, 476 F.2d at 1362-63, 177 USPQ at 568-69.

Statement of the Issue

*Under what circumstances have trademarks been found to travel in sufficiently distinct channels of trade to support a finding of **no likelihood of confusion when used on similar marks?***

How do the marks make different commercial impressions?

At one time, the Board seemed to have a *per se* rule that the use of the same or a similar mark on different items of apparel was likely to cause confusion; yet, more recent decisions re-emphasize that each case is to be determined on its own particular facts and circumstances. *See In re British Bulldog, Ltd.*, 224 USPQ 854 (TTAB 1984).

In the case of *In re British Bulldog, Ltd.*, the Board held that the mark PLAYERS on men's underwear and shoes would not result in consumer confusion as to the source of the goods. Here, the connotation of the term was deemed to be different as applied to the respective goods. The board said that "PLAYERS' for

shoes implies a fit, style, color and durability adapted to outdoor activities. 'PLAYERS' for men's underwear implies something else, primarily indoors in nature."

In this case, the two marks project slightly different connotations, in part because of the stylization of the Applicant's mark. Applicant's mark includes an meaning that is conveyed through the call to action "GET CENSORED" and is reinforced through the drawing of the mark. Said another way, the term "GET CENSORED" imply submitting oneself for close examination or scrutiny by others, in order to remove things that might be offensive or immoral. Since clothing itself (without someone wearing it) is not likely going to be offensive, the terms of the mark might imply that removing the person from the clothing might be required. The meaning of the mark may be somewhat sarcastic in tone. Rather than meaning that the goods itself should be submitted for censor; the meaning would refer to removing the wearer of the clothing from the clothing itself (presumably by someone who might otherwise be attracted to the wearer).

Compare the meaning of the Applicant's mark with the meaning of the Registrant's mark. The Registrant's mark has a "noun meaning" (compared to the "verb meaning" of Applicant's mark). Said another way, Registrant's mark is about what the clothing is. Applicant's mark is about taking action.

Registrant's mark is merely "CENSORED", which implies that the goods have already been examined by government officials and deemed unfit for society, that is, previously forbidden.

Said anther way, Applicant's mark sarcastically infers that others might need to remove them from their clothing. Registrant's mark infers that the clothing itself is forbidden. Ultimately, not only are the marks not identical, they are capable of connoting distinct meanings and suggest different benefits of the products.

How does sale through the owner's online store prevent a likelihood of confusion?

Also, Applicant has amended its description to limit that it sells only through it's online stores. As such, any consumer who purchases from Applicant would necessarily be faced directly with the visual differences between the two trademarks, because, online stores are presented visually to users on computing device screens. Said another way, the visual differences between the marks would be apparent to every consumer that encounter's Applicants store, because, they must see Applicant's mark visually on Applicant's online store presented on their computer screen; which is the only channel of trade specified by the Applicant's goods description.

In the case of *McGregor-Doniger Inc. v. Drizzle Inc.*, 599 F.2d 1126, 202 USPQ 81 (2nd Circ. 1979), the 2nd Circuit found no likelihood of confusion between senior users' DRIZZLER for men's golf jackets and junior user's DRIZZLE for women's overcoats and raincoats. These marks are highly similar, and, the goods are nearly identical — jackets and coats. One factor, which weighed heavily in the junior user's favor, was the *competitive distance* between the marks, citing the District court:

The impression that noncompeting goods are from the same origin may be conveyed by such differing considerations as the physical attributes or essential characteristics of the goods, with specific reference to their form, composition, texture or quality, the service or function for which they are intended, ***the manner in which they are advertised, displayed or sold, the place where they are sold***, or the class of customers for whom they are designed and to whom they are sold. *Drizzle*, 599 F.2d at 1135. (emphasis added)

In this case, Applicant has specified that it markets its products directly to consumers solely through its own online stores. Similar to *McGregor-Doniger Inc. v. Drizzle*, the Board should consider this specific manner in which Applicant advertises, displays and sells its apparel. That is, Applicant's stores only include Applicant's products, to the exclusion of all others. So, consumers would never encounter Applicant's goods in the same context as Registrant's goods, thereby lessening any potential likelihood of confusion. It is easy to see that this could be similar to the sale of golf jackets, which would likely occur in different locations, like pro golf shops on golf courses, rather than woman's fashionable overcoats, which may occur in customary fashion channels. *See also A&H Sportswear, Inc. v. Victoria's Secret Stores, Inc.*, 237 F.3d 198, 57 USP 1097 (3d Cir. 2000) (no likelihood of confusion between senior MIRACLESUIT for swimwear versus junior MIRACLE BRA on swimwear).

In the case of *H. Lubovsky, Inc. v. Esprit De Corp.*, 627 F.Supp. 483, 228 USPQ 814 (SDNY 1986), the court found that the senior user's trademark ESPRIT for footwear was strong enough to create a likelihood of confusion with respect to the junior user's use on shoes, but, did not create a likelihood of confusion with respect to the junior user's use on apparel. The court stated that while there was generally a relationship between footwear and apparel,

...there is also an appreciable distance between plaintiff's shoes and defendant's clothing which diminishes the likelihood of confusion. *Shoes are generally sold in shoe stores or shoe departments of department stores.* Most frequently, therefore, they are either in a different store, or a different department, from sportswear. 627 F.Supp at 488.

So, the court considered that the shoes are generally sold *in separate stores or departments* than other apparel was a factor in finding no likelihood of confusion. Similarly, Applicant has limited its use to only its own online stores. *See also Clark & Freeman Corp. v. Heartland Co. Ltd.*, 811 F.Supp. 137, 25 USPQ2d 2030 (SDNY 1993) (senior user of the mark HEARTLAND for boots could not expand its use to shirts because of the junior user's mark HEARTLAND for clothing, because there had been no likelihood of confusion).

In the case of *Standard Knitting, Ltd. v. Toyota Jidosha Kabushiki Kaisha*, 77 USPQ2d 1917 (2006), the senior users mark TUNDRA for clothing was not likely to be confused with the junior users mark TUNDRA on shirts that were sold in automotive dealerships.

Opposer [senior user] argues that the goods are “inherently” related, contending that automobile manufacturers often use the same trademarks on automobiles and clothing; that it is common for automobile manufacturers to sell both automobiles and clothing and that clothing manufacturers use marks used for their clothing in connection with the sale of automobiles; of the automobile industry, including Toyota [junior user], to use the same trademarks on both automobiles and clothing. 77 USPQ2d at 1933.

The court then goes on to state that the senior user's clothing is sold through customary channels for goods, such as apparel shops and department stores. The junior user's goods were sold through automobile dealerships, which are essentially stores under the control of the junior user, that sell primarily the goods of the junior user, and certainly not goods of the kind offered by the senior user.

In this case, Applicant has similarly specified that its goods are available only directly through its own online store, which does not sell goods of others. *See also, In Re the Shoe Works Inc.*, 6 U.S.P.Q.2d 1890 (TTAB 1988) (no likelihood of confusion between senior user of the mark PALMBAY for shorts and pants shoes and junior user's mark PALM BAY on shoes where the shoes were limited to sales solely through junior user's own stores.)

Finally, the visual impression that Applicant's stylized mark includes is particularly relevant, because, online shopping requires display of the stylization of Applicant's mark. Consumers would always have a chance to consider Applicant's stylization when considering the goods for purchase. So, the online nature of Applicant's stores further reduces the likelihood of confusion.

Conclusion

The Applicant hereby respectfully requests that the Board carefully consider the facts, arguments and amendment presented herein and reverse the Examiner's refusal to register Applicant's mark. Applicant believes that its GET CENSORED mark when sold directly through Applicant's online store, will not be likely to be confused with Registrant's mark CENSORED, because:

1. the goods travel in distinct, non-overlapping channels of trade; because Applicant's goods are only sold in Applicant's online stores; and
2. given the differences in channels of trade and the visual circumstance inherent in online sales, the marks make sufficiently different commercial and visual impressions to avoid confusion.

For all the above reasons, the Applicant respectfully requests that the Examiner allow Applicant's application for the mark, GET CENSORED, to register.

Yours truly,

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